

REMARKS

Applicant's appreciate the Office communication concerning the inadvertent and unintentional failure to respond to the rejection of Claims 10-31 based on Ageishi et al. in view of Schlosberg et al. as set forth in the non-final rejection mailed May 20, 2009.

Claims 10-12, 19, 23, and 26-28 are in the case.

In addition to the rejection over Godwin et al. (US 4,543,420) in view of Schlosberg et al. (US 5,798,319), the response to which is set forth in Applicant's Amendment dated August 18, 2009, the claims are also rejected over Ageishi et al. in view of Schlosberg et al. While it is respectfully urged that this rejection is now moot because of the claims amended per the previous response, this rejection is respectfully traversed for the following reasons.

The present inventors teach in paragraph [0012] of the specification that the process of Ageishi et al. does not achieve a high purity product because, among other reasons, "[s]tripping with steam in the presence of alkali can cause hydrolysis of the ester, which would be expected to increase light ends." Paragraph [0012], second to last sentence, of the present specification.

Ageishi et al. teaches the following steps:

- (i) deoxidized alcohol is esterified with an organic acid;
- (ii) alkaline solution is added to neutralize excess acid;
- (iii) carbon dioxide gas is added to neutralize excess alkali;
- (iv) excess alcohol is recovered (by stripping);
- (v) a purified product is obtained by filtering through filter aid.

Schlosberg et al. does not cure the deficiencies of Ageishi et al. and any combination is merely picking and choosing that cannot fairly suggest the improvements claimed.

First of all, Schlosberg et al. is concerned with oxidative stability in a composition to be used as a lubricant, whereas both the present invention and Ageishi et al. are concerned with material for insulation such as in cable wiring. Accordingly, one of skill in the art would not

look to Schlosberg et al. to "try" to modify Ageishi et al. in order to improve carbonyl number, lights ends, and liquid volume resistivity, parameters now claimed.

Secondly, even if one of skill in the art were to look to Schlosberg et al. for alternative steps, it is clear that the secondary reference does not, in fact, teach avoidance of stripping prior to filtering. Rather, as set forth in detail in column 5 of Schlosberg et al., the reference teaches:

- (i) esterification;
- (ii) addition of absorbents;
- (iii) addition of base;
- (iv) removal of water "in a flash step" (e.g., stripping)
- (v) filtration of solids from "the bulk of excess alcohol" (emphasis added);
- (vi) removal of excess alcohol by stripping;
- (vii) removal of residual solids by filtration.

Thus, Schlosberg et al. does not avoid a stripping step before filtration. Clearly step (iv) heats the product, along with water and alcohol, in the presence of solids and base. As taught in the present specification (vide supra), such a step of stripping in the presence of basic material (alkali) and solids would be expected to lead to increase in light ends in the final product, which is avoided by the present claims. Furthermore, it is also clear from the adjectival expression "the bulk", it is recognized by Schlosberg that some alcohol is removed before step (v), i.e., in step (iv). Schlosberg et al. went the extra step of adding the expression "the bulk" because he knew that not insignificant portions of alcohol would be removed in the flashing step (iv).

One of ordinary skill in the art also would not combine Ageishi et al. with Schlosberg et al. because the addition of absorbents occurs late in the former reference but early in Schlosberg et al. The suggestion of a selective reversal of steps in Ageishi et al. to meet the limitations of the present invention is "picking and choosing" selectively from the secondary reference while avoiding consideration of the invention as a whole. There would be no reason to alter Ageishi et al. in the manner suggested unless the absorbents are added first, as in Schlosberg et al. In the present invention, as set forth in Claim 10, the absorbents are added last and then filtered.

Appl. No.: 10/568,699
Atty. Docket No.: 2003M091
Office Action dated October 28, 2009
Date: November 3, 2009

For these reasons, it is believed that the present claims are in conditions for allowance and early notice to this effect is earnestly solicited.

Respectfully submitted,

November 3, 2009

Date

/Andrew B. Griffis/

Andrew B. Griffis
Attorney for Applicants
Registration No. 36,336

Post Office Address (to which correspondence is to be sent):
ExxonMobil Chemical Company
Law Technology Department
P.O. Box 2149
Baytown, Texas 77522-2149
Phone: (281) 834-1886
Fax: (281) 834-2495